

REMARKS:

This application has been carefully reviewed in view of the Final Office Action dated 3/19/2009. Applicant respectfully traverses all rejections and requests reconsideration in view of the following:

Request for Interview

Applicant respectfully requests the courtesy of an interview in order to expedite prosecution of the present application.

Regarding Paragraphs 1-3

Applicant notes that the Examiner has invoked MPEP 821.03 and deemed that the newly submitted claims 87-103 are withdrawn from consideration as having been drawn to separate inventions. Applicant reserves the right to submit these claims in divisional applications for further prosecution, and takes the position that the Examiner's actions in this regard amount to a restriction and election, thereby providing the same immunity to double patenting that would have been afforded had the requirement to file these claims come as a result of a more conventional restriction and election. Applicant agrees that these claims are independent and distinct for the reasons submitted by the Examiner and requests that the Examiner present evidence that no such double patenting immunity exists if he disagrees with this position. Otherwise, the Office is presumed to have admitted that Applicant's position is in fact the case.

Regarding the Rejection Under 35 U.S.C. §103

Applicant respectfully traverses the current rejection of claim 104. In order to establish *prima facie* obviousness, in accord with *Graham v. John Deere*, 383 U. S. 1 (1966), the Supreme Court set out a framework for applying the statutory language of §103 in making an objective analysis of obviousness. The Court stated that "under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long

felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” This criteria was reaffirmed in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (S.Ct.2007), 127 S.Ct.1727 (2007). It should be noted that in this case, the Supreme Court did not throw out the so-called teaching, suggestion, motivation test (TSM), but rather indicated that it should not be applied rigidly since other tests could be used to determine obviousness. Additionally, MPEP 2143.03 requires a clear articulation of the reasons why one of ordinary skill in the art would find a claim obvious, and provides a number of example scenarios.

In accord with the *Graham v. John Deere* analysis, in order to establish *prima facie* obviousness, it is the burden of the Office to identify each element of the claims in the prior art and further, to provide an explicit analysis as to the reasoning to support a conclusion of obviousness. (See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) - “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).

Additionally, it is noted that MPEP 2143.03 requires that all claim features must be considered during examination. “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Claim 104 calls out in part “responsive to a navigation command from the remote controller, generating a signal for displaying a second navigable list of menu options associated with the highlighted field, the second navigable list of menu options arranged in a second linearly configured set of fields which intersect the first linear configuration of fields of the first navigable list of menu options at the highlighted location and overlaying the AV content currently playing on the display”. The Office asserts that this claim feature is shown in Wilcox at Figs 3-4 and 7 and asserts that the “second navigable list of menu options 114 of second linear configuration having fields 122 and intersects the first linear configuration wherein second navigable list is associated with the highlighted 110” (pages 3 and 4 of the Office Action). However, upon review of the cited portions of

Wilcox, Applicant finds no indication in the specified figures or text that the “second linearly configured set of fields … intersect the first linear configuration of fields” as asserted. For this to be the case, fields 120 would have to intersect fields 122. It is noted that the claim explicitly calls for “intersection” of the fields, not “association” as argued. Hence, the Office Action fails to establish *prima facie* obviousness since at least this feature has not been identified in the Wilcox reference as asserted.

Neither the Gospel nor the Knowles references are asserted to remedy this deficiency, and hence, the combination fails to establish *prima facie* obviousness for failure to identify all claim features.

It is further noted that the claim calls for “the AV content currently playing on the display continues to play unless the menu option selected is a menu option that begins playing a different selection of AV content”. This is asserted to be met by Gospel and the combination is asserted to be obvious “in order to provide users with tuning/selections feedback. However, this fails to account for the AV content to continue to play if a menu option does not select a different selection of AV content. Hence, the reasons for the combination are inapplicable to a portion of the claim’s scope and the requirements for an articulated reasoning per *In re Kahn* have not been fully met.

In view of the above, it is respectfully submitted that claim 104 has not been established to be *prima facie* obvious in light of the proposed combination. Accordingly, reconsideration and allowance are respectfully requested.

It is noted that the above response is provided on the assumption that the Office Action contains minor errors at page 4, lines 11 and 20, where “Carlson” is believed to be erroneously called out instead of “Wilcox” and “Gospel” respectively. If this is not the case, then the undersigned submits that the Office Action is defective and requests a new Office Action that restarts the period for response.

Conclusion

Reconsideration and allowance of claim 104 are respectfully requested. If further matters remain to be resolved in this application, Applicant earnestly invites the Examiner to contact the undersigned in order to expedite prosecution by way of an interview. The undersigned can be contacted at the telephone number below.

Respectfully submitted,

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